

Remarks

The Office Action raises two (2) issues: (a) a 35 U.S.C. sec. 112 issue and (b) a 35 U.S.C. sec. 103 issue.

The Claims have been redrafted to overcome each of these issues.

The Claims have been drafted to particularly point out and distinctly claim the subject matter of Applicant's invention, so it is no longer vague or indefinite. In this way, Applicant's response overcomes the PTO's first issue raised, namely, 35 U.S.C. sec. 112.

With respect to the second issue, namely 35 USC sec. 103, the PTO objects to issuing a patent to Applicant, because the invention has been determined by the PTO as being "obvious" in light of a combination of at least 3 "prior art" documents; specifically, two patents and 1 article. The new Claims, the remarks herein and the commercial success of the invention show that Applicant's invention, as viewed as a whole, is un-obvious to one skilled in the art.

Responding to the Office Action of 2/5/2007 and the associated code section 35 U.S.C. 103 (a) objection, Applicant points to the leading case in this area, Graham v. John Deere, 383 U.S.1, 148 USPTO 459 (1966). In Graham, the following analytical steps were announced to determine the test for obviousness vs. un-obviousness:

- 1) Determine the scope & content of the prior art. In this matter, there are several patents and an article that the PTO cites. Some, of which, Applicant believes should not be considered "prior art".

- 2) Determine the novelty of the invention. In this matter, no one patent or article cited by the PTO depicts all the elements of the current invention as disclosed and claimed.
- 3) Determine the level of skill of artisans in the pertinent art.
- 4) Against this background, determine the obviousness or un-obviousness of the inventive subject matter. In making this determination, one should evaluate the invention as a whole. The invention must be considered as a whole. Rockwell Int'l Corp. v. United States, 147 F. 3d 1358 (Fed. Cir. 1998).
- 5) Finally, one must consider secondary and objective factors such as commercial success, long felt but unsolved need and failure of others. Importantly, the Federal Circuit has instructed that these secondary considerations and objective factors **must be considered** in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir.1986) (emphasis supplied).

First, one must consider the scope and content of the “prior art” cited. One reference is to U.S. Patent No. 6,413,562 to Conforti et al. (“Conforti”). But Conforti’s invention is for “healthy bread crumbs.” Applicant’s invention has nothing to do with “healthy bread crumbs.” In fact, it is just the opposite; Applicant’s invention avoids flour altogether. The elements of Conforti comprise whole wheat flour, rye flour, whole grain flour, baked blue tortilla chips, potato chips, tortilla chips, any type of nuts, whole grain pretzels, and oat or bran product. Conforti does not even mention almond meal, flax seed meal or soy flour (as admitted by the PTO’s response), which are the primary ingredients

of Applicant's invention. Conforti does mention, but does not claim, salt and crushed almonds, but crushed almonds (as is stated in the PTO's response) is not the same as almond meal and numerous recipes contain salt. Thus, Conforti should not be even considered prior art under the Patent law. See, In re Clay, 966 F. 2d 656 (Fed Cir. 1992).

But, assuming for discussion, that Conforti is considered prior art (which Applicant denies), the Patent Office cites Conforti for the contention, Applicant assumes, that Conforti contains some of the seasoning as that of Applicant's invention. Applicant does not deny that there are several recipes in the United States that contain some of the seasoning (such as salt, pepper, garlic and the like) of Applicant's recipe but taken as a whole, as the Patent law requires, no one recipe discloses the invention of Applicant and Applicant's invention is un-obvious to one skilled in the art. Further, in the response from the PTO, it is admitted that Conforti does not disclose almond meal, flax seed meal or soy flour, the main ingredients of Applicant's invention.

Another "prior art" document raised in the PTO's Office Action is the article written by Steven Pratt (the "Article"). The PTO's Office Action states that the Article "teaches flax seed flour." However, the Article never mentions "flax seed flour." It does mention the use of flax seed. But as disclosed in Applicant's patent application, the use of flax seed meal, instead of flax seed, is critical because the human body does not digest flax seed. (see, page 7, item (2) of Applicant's Patent Application). That is why Applicant's recipe uses flax seed meal, not flax seed. The Article also mentions "flax flour." But Applicant's recipe avoids the use of flour and it is unclear whether "flax flour" is in fact "flax seed flour" as mentioned incorrectly that the Article uses that term.

Thus, again, the Article should not be even considered “prior art” under the Patent law. See, In re Clay, 966 F. 2d 656 (Fed Cir. 1992).

But, assuming for discussion, that the Article is considered prior art (which Applicant denies), the Patent Office cites the Article for the contention that the Article makes reference to “flax seed flour” (which it does not). Assuming it did, the Article does not disclose almond meal or soy meal or the seasoning disclosed in Applicant’s patent application. Thus, Applicant’s recipe taken as a whole, as the Patent law requires, is unobvious to one skilled in the art.

U. S Patent No. 4,277,502 to Kurzius is for “preparing yeast raised bakery products using glandless cotton-seed.” Applicant’s invention does not have anything to do with yeast or cotton-seed. But, nevertheless, the primary ingredients of Kurzius are cracked, glandless cotton-seed, water, salt, yeast, sour culture, and flour. The only common ingredient with Applicant’s invention is salt. Applicant does admit that many recipes in the United States contain salt. Kurzius, to be fair, also mentions that optionally one could add: malt and other types of flour such as rye flour, whole-wheat flour, corn, fax seed, oats, barely, soy flour, tritcale, rice and other coarse ingredients and additionally a sour ingredient such as sour culture, lemon juice or other acids can be added. So, Kurzius does mention salt, and soy flour; it does not mention flax seed meal. The PTO’s response states Kurzius mentions “flax seed” which is correct, but Applicant’s recipe avoids flax seed and specifically says not to use flax seed.

So, assuming all of the documents the PTO cites are “prior art,” which Applicant denies, none of them contain the following ingredients:

- (a) almond meal (almond meal is not the same as crushed almonds as is admitted in the Office Action; further, almond nut is not the same as almond meal, does not mix the same and therefore does not stick to food in the same way);
- (b) Dehydrated garlic;
- (c) Dehydrated Onions; and
- (d) Red pepper.

While Conforti does mention “onion” and “garlic” and “black pepper”, it does not mention “dehydrated garlic,” “dehydrated onions,” or “red pepper.” So, Applicant’s invention cannot be obvious to one skilled in the art when not even all the ingredients of Applicant’s invention are disclosed in the “prior art” references.

But continuing to apply the Graham test, second, one must determine the novelty of Applicant’s invention. In this matter, as one can see from the above recitation of the patents and Article cited, no one patent or Article cited by the PTO depicts all the major elements of the current invention as disclosed and claimed.

Third, one must determine the level of skill of artisans in the pertinent art. The prior art references must suggest to the skilled artisan that they can be combined and that combination would have a reasonable probability of success. See, Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F. 3d 1568 (Fed.Cir. 1996). In this case, there is no suggestion in the prior art to combine these patents and Article. Care must be taken to avoid hindsight reconstruction by using a patent application as a guide to combine a maze of prior art references and combine them in the right way so as to achieve the result of

obviousness. See, Grain Processing Corp. v. American Maize-Products Co., 840 F. 2d 902 (Fed. Cir. 1988).

Fourth, against this background, one must determine the obviousness or unobviousness of the inventive subject matter. In making this determination, one should evaluate the invention as a whole. The invention must be considered as a whole.

Rockwell Int'l Corp. v. United States, 147 F. 3d 1358 (Fed. Cir.1998). When one considers the invention as a whole, one determines that no one patent or the Article contains all the elements claimed in Applicant's invention.

Finally, one must consider secondary and objective factors such as commercial success, long felt but unsolved need and failure of others. Importantly, the Federal Circuit has instructed that these secondary considerations and objective factors must be considered in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir.1986) (emphasis supplied). The relevant evidence on the obviousness vs. non-obviousness issue, the Court, even in Graham, said, and as other courts have emphasized, it must include evidence on secondary considerations and it is error to exclude that evidence from consideration. See, Stratoflex, Inc. v. Aeroquip Corp., 713 F. 2d 1530 (1983). The product is a commercial success because it has been carried in Publix Grocery Stores for over 14 months.

In further response to the obvious vs. un-obvious issue, in this matter, this is not a mere substitution of one element for another to come up with a new invention like in Hotchkiss v. Greenwood, 52 U.S. 248 (1850). The Applicant, with respect to his invention, developed a wholly new recipe which, as a whole, is not disclosed by any one patent or the Article cited by the PTO.

With respect to Applicant's invention, the combination he created is a new recipe with such combination, as a whole, not reading on another patent or Article. Further, unlike in Graham, Applicant's invention is not a mere modification of an existing recipe (where Graham merely reversed the shank and hinge plate's position to create a new invention which was held to be obvious). Applicant has provided a new recipe and is un-obvious to one skilled in this art.

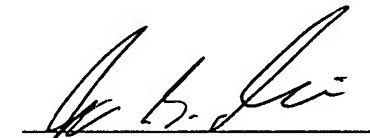
There is no one patent or Article cited that cites all the elements listed in Applicant's disclosure and the newly written Claims.

The Patent and Trademark Office has to combine three documents in order to try to show obviousness. The need to combine so many documents, by definition, shows un-obviousness, rather than obviousness. The more prior art documents needed to try to depict obviousness proves that the invention is un-obvious.

Conclusion

For all the foregoing reasons, Applicant submits that the specification and Claims are now in proper form, and that the Claims all define patentably over the prior art. Therefore, Applicant submits that his patent application is now in condition for allowance, which action he respectfully requests.

Very Respectively,



Joseph G. Mitchell

Title : Patent Attorney

PTO # 40,730

Address:

4521 Derby Lane

Smyrna, GA 30082

Phone : 404-943-2981

e-mail: joeymitch@earthlink.net

Dated : 5-3-2007